

Remarks

Claims 1-20 are pending in the subject application. By this Amendment, claims 1, 3, 8, 11, 13, 16, and 19 have been amended and claims 21 and 22 have been added. The new claims find support at, for example, paragraph 0016 of the specification. No new matter has been introduced. Upon entry of these amendments, claims 1-22 will be before the Examiner. Favorable consideration of the pending claims is respectfully requested.

Claims 1-7, 9-12, 14, and 19-20 stand rejected under §102(b) as anticipated by Kurland (U.S. Patent 4,653,482). Applicants respectfully request reconsideration. Kurland discloses a lateralization device comprising a threaded supporting member and a complimentary lateralization member rotatably mounted thereon. The angular orientation of Kurland's lateralization member can be adjusted against the supporting member, but this does not adjust the lateralization effect. Rather, the lateralization effect of Kurland is varied by moving the entire lateralization device, including the supporting member, along a lateral slot. Claim 1 has been amended to clarify that the lateralization effect can be altered merely by adjusting the angular orientation of the lateralization member against the supporting member. This is nowhere taught or suggested by Kurland. Claim 19 has also been amended in that respect to clarify that the claimed method cannot inherently be practiced by using the Kurland device.

It is a basic premise of patent law that, in order to anticipate, a single prior art reference must disclose within its four corners each and every element of the claimed invention. In *Lindemann v. American Hoist and Derrick Co.*, 221 USPQ 481 (Fed. Cir. 1984), the court stated:

Anticipation requires the presence in a single prior art reference, disclosure of each and every element of the claimed invention, arranged as in the claim. *Connell v. Sears Roebuck and Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983); *SSIH Equip. S.A. v. USITC*, 718 F.2d 365, 216 USPQ 678 (Fed. Cir. 1983). In deciding the issue of anticipation, the [examiner] must identify the elements of the claims, determine their meaning in light of the specification and prosecution history, and identify corresponding elements disclosed in the allegedly anticipating reference. *SSIH, supra*; *Kalman [v. Kimberly-Clarke]*, 713 F.2d 760, 218 USPQ 781 (Fed. Cir. 1983)] (emphasis added). 221 USPQ at 485.

Because Kurland does not teach each and every element of the claims, it cannot anticipate. Accordingly, Applicants respectfully request this §102 rejection be withdrawn.

Next, claims 8, 13, and 16-18 stand rejected under §103(a) as obvious over Kurland in view of Kostich (U.S. Patent 5,623,949). Applicants respectfully traverse. The examiner acknowledges that Kurland fails to teach that the recessed portion is located in an eccentric position on the cylindrical member. The Office Action then relies on Kostich for purportedly teaching a positioning device comprising eccentric cylindrical members. The "eccentric cylindrical members" of Kostich are merely handgrips. As such, they are not a "lateralization member" as specified in the subject claims. There is simply no motivation to modify a "lateralization member" as disclosed by Kurland to have an eccentric shape as depicted in the "handgrips" of Kostich. In fact, Kostich is completely silent about the shape of his handgrips, their eccentricity being evident only from the illustration provided in Kostich Figure 1. In fact, as is made clear by Kostich Figure 2, their eccentricity, if any, is caused by the handlebar 140.

It has been well established in the patent law that the mere fact that the purported prior art could have been modified or applied in some manner to yield an applicant's invention does not make the modification or application obvious unless "there was an apparent reason to combine the known elements in the fashion claimed" by the applicant. *KSR International Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 550 U.S. ____ (2007). Furthermore, an applicant's invention is not "proved obvious merely by demonstrating that each of its elements was, independently, known in the (purported) prior art." *Id.*

The Office Action does not set forth reasoning why the skilled artisan would be motivated to alter the shape of Kurland's lateralization device based on a mere drawing of handgrips/handlebars in Kostich. The only asserted reason, "to better receive body parts and provide the user with more comfort," is speculative at best, and in any case would only apply if Kurland (and the invention claimed) was using a handgrip. This is clearly not the case.

Further, claim 8 has been amended to depend from claim 7, which specifies the cylindrical member has a substantially circular cross-section and claim 13 has been similarly amended. Claims 16-18 already include this limitation, which is nowhere suggested by Kostich. Thus the proposed combination of Kurland and Kostich cannot yield the claimed invention. Accordingly, Applicants respectfully request this obviousness rejection be withdrawn.

Finally, claim 15 stands rejected under §103(a) as obvious over Kurland in view of Spetzler *et al.* (U.S. Patent 6,805,453). Applicants respectfully request reconsideration. Claim 15 depends

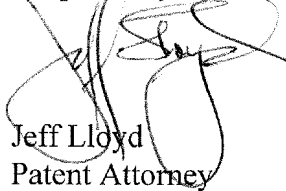
from claim 1, which as amended above, is clearly not anticipated by Kurland, and Spetzler fails to cure those deficiencies in being merely cited for providing a protective cover.

In view of the foregoing remarks and amendments to the claims, Applicants believe that the claims as currently pending are in condition for allowance, and such action is respectfully requested.

Applicants invite the Examiner to call the undersigned if clarification is needed on any of this response, or if the Examiner believes a telephonic interview would expedite the prosecution of the subject application to completion.

The Commissioner is hereby authorized to charge any fees under 37 C.F.R. §§ 1.16 or 1.17 as required by this paper to Deposit Account 19-0065.

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